

REMARKS

The November 13, 2008 Office Action regarding the above-identified application has been carefully considered; and the claim amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action. The claims have been amended, mainly to address the art rejection from the latest Office Action. Care has been taken to avoid entry of new matter. For example, the recitation of previous claim 19 has been moved up into the independent claims. Also, the independent claims have been amended to more explicitly recite the definition of the “automatic return” and “return required” conditions. For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this amended application is requested.

The latest Office Action rejected claims 1, 2, 4-8, 12-21 and 23 under 35 U.S.C. §103(a) as unpatentable over U.S. Publication No. 2003/0005135 to Inoue et al. (hereinafter Inoue) in view of U.S. Publication No. 2004/0193680 to Gibbs et al. (hereinafter Gibbs), U.S. Publication No. 2004/0034786 to Okamoto et al. and U.S. Patent No. 6,925,278 to Ferrante et al. (hereinafter Ferrante). Claim 24 stands rejected under 35 U.S.C. §103(a) as unpatentable over Inoue, Gibbs, Okamoto and Ferrante, further in view of U.S. Publication No. 2002/0007351 to Hillegass et al. (hereinafter Hillegass). Applicants respectfully traverse these art rejections.

Applicants respectfully submit that the documents applied in the rejections, even taken together, do not fairly suggest a system, server or terminal that satisfies all of the recitations of Applicants’ respective independent claims. Applicants further submit that the combination of teachings arbitrarily selected from so many documents would not have been obvious to one of skill in the art, in the legal sense of 35 U.S.C. §103. Hence, the claims patentably distinguish over the art and the rejections are improper and should be withdrawn.

The server referenced in the various pending independent claims is capable of automatically restoring a temporary license, which was issued to a terminal, without a return of the license from the terminal, under certain circumstances. The newly cited reference, Ferrante, seems to disclose an automatic return function based on timer expiration (see e.g. column 6, lines 1-11). However, a return mode included in a use condition of the temporary license is not disclosed by Ferrante. Inoue, Gibbs and Okamoto seem to disclose a kind of a return mode, but the return mode disclosed in those documents is determined based on a license condition that is set in a server. In other words, the return mode in the references cannot be determined or changed based on a request from the terminal.

To clarify a difference between the claims and the cited references, Applicants have added new limitations into each independent claim to:

- (1) Clarify the meaning of “automatic return” and “return required;”
- (2) Clarify that an issuance unit in the server determines whether or not a return mode flag included in a request from a terminal matches the return mode flag in a second memory unit, sets the return mode flag included in the request from the terminal into the second license if matching, and sets a return mode flag of a first license into the second license when a return reject flag included in the request from the terminal is a predetermined value if not matching; and
- (3) Clarify that a return control section in the server sets the return mode flag into the second license depending on the request from the terminal.

For example, in relevant part, claim 1 now recites:

... a return mode flag which indicates one of (a) an automatic return and (b) return required, wherein: automatic return indicates that a return state of said second license is automatically restored without a return of said second license, and return required indicates that a return of said second license from said terminal is required to restore said return state of said second license;

said issuance unit in said server determines whether or not a return mode flag included in said request from said terminal matches said return

mode flag in said second memory unit, sets said return mode flag included in said request from said terminal into said second license if matching, and sets a return mode flag of said first license into said second license when a return reject flag included in said request from said terminal is a predetermined value if not matching,

said return control section in said server sets said return mode flag into said second license depending on said request from said terminal and restores a number of simultaneous issues of said first license when said return control section automatically restores to said return state of said second license,

Similar recitations appear in independent claims 2 and 16. In the claims, the issuance unit issues the license according to a “request from” the terminal. Hence, each of the independent claims requires that the issuance unit determines whether or not a return mode flag included in the request from the terminal that relates to issuance matches the return mode flag in a second memory unit. The recited issuance unit sets the return mode flag included in the request from the terminal into the second license if matching, and sets a return mode flag of a first license into the second license when a return reject flag included in the request from the terminal is a predetermined value if not matching. Each independent claim then recites that the return control section in the server sets the return mode flag into the second license depending on the request from the terminal.

The processing based on the request from the terminal (the request according to which the second license is issued) is useful in case that the return mode is changed based on an environment of the terminal, which is used in different environments that may and may not be connectable to a network, e.g. for a “desktop” terminal which is always connected to a network and for a mobile terminal which is not always connected to a network. In such case, the flexibility of the return mode based on a request from the terminal is quite useful and gives the recited subject matter a technical advantage.

The Office Action that the feature of the new claim 1, which was formerly recited in claim 19, is disclosed in Okamoto (see page 35). However, Applicants disagree because

Okamoto merely discloses an automatic return function and fails to disclose the return processing based on the request from the terminal in the manner now recited in each independent claim, such as in the portions of claim 1 quoted above. As can be seen in Fig. 16 and paragraphs 0191-0208 of Okamoto, for example, the return mode is fixed in the server and it cannot be determined depending on a request from the terminal. In the second embodiment of Okamoto, as another example, the return flag judgment unit 307b determines whether the license data (LD) 80b which allows content usage needs to be returned to the right management server 20b or not, based on the on-usage-end return flag 844 and the on-right-lapse return flag 845 in the LD 80b (paragraph 0286). However, it is the LD generation unit 24b that produces the LD 80b from the license data 222b under the management of the license data database 22b (see e.g. paragraph 0240). The LD generation unit 24b and the license data database 22b are elements of the right management server 20b (see FIG. 20). In the example of FIG. 25, the issuance request lacks a return mode flag. Again, the return mode is fixed in the server and it cannot be determined depending on a request from the terminal.

In such examples of Okamoto, the return mode cannot be changed based on an environment of the terminal (e.g. as indicated by the request flag), where the terminal may be used in an environment connectable to a network or in an environment that may not be connectable to a network. Hence, none of the combinations proposed in the rejections, which rely on Okamoto for the return mode feature, would have the server determine whether a return mode flag included in the request from the terminal matches or not the return mode flag in the second memory unit and then proceed based on that determination in the manner claimed.

For at least these reasons, neither combination applied to reject Applicants claims in the latest Action would actually meet all requirements of any of the pending independent claims.

The claims therefore all patentably distinguish over the combinations proposed in the art rejections.

It is also submitted that the proposed combinations would not have been obvious, under the relevant legal standards. To support a conclusion of obviousness, there must be some rationale or reasonable basis for modifying the prior art, underpinning the proposed combination of references. The starting point of the rejections is (1) Inoue. The Examiner recognizes that Inoue does not teach many different aspects of Applicants' claims. Instead, the first rejection cites (2) Gibbs, (3) Okamoto, and (4) Ferrante, just to meet the independent claims. To meet claim 24, the second rejection cites the same four references and further cites to (5) Hillegass. It is respectfully submitted that there is no reason or appropriate rationale to arbitrarily pick and choose piece-parts from so many diverse sources in the particular manner selected in the rejection, other than a vain effort to re-create Applicants' claims using improper hindsight. Although some reason for one or more of the individual piecemeal modification(s) may be apparent at this late date, it is submitted that there would not have been one overarching reason for so extensive a modification of Inoue, apparent to a skilled artisan prior to Applicants' invention of the claimed subject matter. Hence, neither combination would have been obvious in the sense of 35 U.S.C. §103.

In view of the distinctions over the proposed combinations and the fact that the combinations would not have been obvious to a person of skill in the art, it is believed that the pending claims are patentable over the art and the rejections should now be withdrawn.

Upon entry of the above claim amendments, claims 1, 2, 4-8, 12-19, 20, 21, 23 and 24 remain active in this application, all of which should be patentable over the art applied in the Action. Applicants therefore submit that all of the claims are in condition for allowance.

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Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the November 13, 2008 Office Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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